



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/570,737

09/28/2006

Raphael Mechoulam

0-06-058

8698

42009

7590

03/26/2010

KEVIN D. MCCARTHY

ROACH BROWN MCCARTHY & GRUBER, P.C.

424 MAIN STREET

1920 LIBERTY BUILDING

BUFFALO, NY 14202

EXAMINER

DAVIS, BRIAN J

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

03/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/570,737	Applicant(s) MECHOULAM ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-16, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 17 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/7/06; 4/6/07; 6/17/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Clarification

Due to reasons internal to the USPTO, this application has been reassigned. The examiner regrets this inconvenience to applicant.

Information Disclosure Statement

The lined-through entries on the IDSs are incomplete (missing date, page numbers, etc.).

112 Rejections Withdrawn

The rejection of claims 5 and 17 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment and arguments. Applicant's amendment and arguments have been carefully considered and are persuasive.

102 Rejections Withdrawn

The rejection of claims 1-5 and 17 under 35 USC 102(b), outlined in the previous Office Action, is withdrawn. As applicant correctly points out, the rejection is improper.

Election/Restriction

For completeness of the record, the examiner states that the election/restriction is hereby made FINAL.

Applicant having overcome the outstanding rejection, the search was expanded as called for under current Office Markush examination practice. In the interest of furthering prosecution the subject matter of the elected claims where R' is -COOH or -CH₂OH (and all other variables are allowed to vary over their full range) has been completely searched. Thus, the subject matter of claims 1-4 has been completely searched. The subject matter of claims 5 and 17 has been completely searched with the exception of the set of compounds when R'=CH₃.

Claim Rejections - 35 USC § 102, NEW

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Recent Dev. Mass Spectrom. Biochem. Med.*, [Proc. Int. Symp.], 4th (1978), Meeting Date 1977, Vol. 1, p. 161-184 (CAPLUS abstract). The reference teaches applicant's compound: RN= 68295-94-3.

Claims 5 and 17, in so far as they read on the species defined below, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *British Journal of Pharmacology* (2001), 134(4), p. 845-852 (CAPLUS abstract; in IDS as full paper). The

Art Unit: 1621

reference teaches applicant's compounds and compositions: RN= 393588-66-4; RN= 393588-67-5. The examiner notes that the limitation in the claims stating what the compound or composition is *for* cannot distinguish over known compounds or compositions. This is so because a compound and its properties are inseparable. *In re Papesch*, 315, F.2d 381, 137 USPQ 43 (CCPA 1963).

Allowable Subject Matter

Claims 3 and 4 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached at 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian J. Davis/
Primary Examiner, Art Unit 1621
3/24/10